

REMARKS/ARGUMENTS

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

The Applicant has amended claims. The Applicant respectfully submits that the amendments to the claim set are fully supported by the originally filed specification.

Claim Rejections – 35 USC § 103

The Examiner in the Advisory Action has maintained the rejections from the Final Office Action. Thus the Examiner has rejected claims 1 to 3, 8 to 20, 24 to 31, 36 to 43 and 47 as being unpatentable over Patterson, Jr et al. (US Patent No. 5,797,002) in view of Richards et al. (US Patent No. 6,539,361 B1). Furthermore, the Examiner has rejected claims 21 to 23, 44 to 46 and 48 as being unpatentable over Patterson Jr et al. in view of Richards et al. and in further view of Sekunder (WO 97/22959).

Claim 1 has been amended to refer to a method of enabling a banking customer to perform a banking transaction via a printed form. Claim 29 has also been amended to refer to a printed form. This clarification of a printed form has been incorporated into claim 1 from claim 21. Support for this feature can also be found on page 16 under the title "Netpages".

Claims 1 and 29 have been amended to refer to the sensing device sensing at least some of the coded data on the printed form and generating the indicating data using the sensed coded data. This amendment clarifies that the sensing device is an active device (ie. the sensing device generates data) and not a passive sensing device. A basis for the sensing device generating indicating data using at least some of the sensed coded data can be found at pages 30 and 31 of the specification under the title "The Netpage Pen" which refers to the pen performing the tasks of decoding IR position tags, encrypting captured information and determining the sensing device's position and orientation relative to the page. These tasks are examples of the generation of indicating data using the sensed coded data. Thus, the sensing device is an active device, not a passive device.

Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

Obviousness can only be established by combining or modifying teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In particular, the MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Patterson, Jr. et al states at column 3, lines 23 to 33:

"The transcribed instructions must be delivered to the floor brokers and the transcribed executions and quotes must be retrieved from the floor broker and returned to the booth clerk promptly. However, the slips of paper on which the orders and quotes are recorded can be easily misplaced, and if dropped, can be lost among a plethora of discarded slips that were scribbled in a trading frenzy. Any attempt to locate a slip dropped onto the crowded trading floor will be frustrated by the constant movement of floor brokers, pages, and the like."

Clearly, Patterson, Jr. et al is teaching that paper based forms are not suitable for this type of technology. Thus, Patterson, Jr et al. has proposed a solution using a hand held stylus. This teaching of Patterson, Jr et al contrasts to the claimed method and system which explicitly states that the form is a "printed form".

We draw the Examiner's attention to MPEP §2141.02 "*Differences Between Prior Art and Claimed Invention*" which states:

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)."

As Patterson, Jr et al. includes portions that would lead away from the claimed method and system, Patterson, Jr et al. should clearly not be considered relevant for a 35 USC § 103 rejection.

Furthermore, Sekunder proposes a system using a surface including paper (Abstract). Thus, why would a person of ordinary skill in the art combine Patterson, Jr et al. which teaches to avoid paper based solutions with Sekunder which teaches a paper based solution. Clearly they are extremely opposite arts and a person of ordinary skill in the art would not be motivated to combine the two documents together.

Thus, in light of these comments, the first basic requirement a Prima Facie Case of Obviousness has not been met with regard to Patterson, Jr et al. in view of Richards and further in view of Sekunder, as stated at MPEP §2143. Patterson, Jr et al. suggests that paper based solutions are inferior which totally contrasts to Sekunder which provides a paper based solution (or at least a printed surface which acts similarly to a paper based solution).

Moreover, the second basic requirement of a Prima Facie Case of Obviousness has not been met with regard to Patterson, Jr et al. in view of Richards and further in view of Sekunder.

The above-highlighted section of Patterson, Jr et al. suggests that paper based solutions are unsatisfactory. Thus, there would be no reasonable expectation of success to combine the teachings of Patterson, Jr et al with Sekunder.

Additionally, the third basic requirement of a Prima Facie Case of Obviousness has not been met with regard to Patterson, Jr et al. in view of Richards and further in view of Sekunder.

The Examiner has stated that Patterson, Jr et al shows coded data indicative of an identity of the form. However, the Examiner has failed in the past three Office Actions to specifically point out where Patterson, Jr et al shows coded data indicative of an identity of the form.

The Examiner has indicated somewhere between line 20 of Column 13 to line 55 of Column 15 that Patterson, Jr et al. shows this feature. However, we have analysed this section of Patterson, Jr et al. numerous times, yet Patterson, Jr et al fails to describe coded data indicative of an identity.

We stress to the Examiner that failing to point out the individual integer during multiple Office Actions is not progressing the prosecution of the current application. We would appreciate that if the Examiner is to maintain any rejection involving Patterson, Jr et al, showing an identity of the form, a specific line number should be quoted in the next Office Action to progress the prosecution.

Considering the technology which Patterson, Jr et al is discloses, why would a computer need coded data which is indicative of the form? The computer can interpret which window is active on the display and by using the pressure applied by the stylus on the tablet, the identity of the form can be determined. Thus, it can be seen that there is absolutely no need for the form displayed on the computer screen to include coded data indicative of an identity of the form. Thus, Patterson, Jr et al would not even imply coded data indicative of an identity of the form.

Sekunder fails to disclose any coded data which is indicative of an identity of the form. Sekunder only discloses data on the surface which is indicative of an absolute coordinate on the surface.

Therefore, even if Patterson, Jr et al. was combined with Richards et al and then further combined with Sekunder, the coded data would fail to be indicative of an identity of the form. Thus, the third basic requirement of a Prima Facie Case of Obviousness has not been met with regard to Patterson, Jr et al. in view of Richards and further in view of Sekunder, as all the claim limitations, in particular coded data indicative of an identity of the form, have not been shown by these documents.

Additionally, the sensing device shown by Patterson, Jr et al is a passive device. As stated by Patterson, Jr et al. at lines 59 to 65 of column 8:

"Such input devices may include those having a plastic stylus for applying pressure at individual or groups of screen picture elements, or may be designed to effect a local change of electric or magnetic field, for example, by providing a resistor at the tip of the input device to drain charge, when the device is positioned or lightly applied in the vicinity of a screen picture element."

Thus, the stylus is passive as it fails to generate any data. The screen determines the position due to either pressure or changes in magnetic/electric fields.

Sekunder fails to disclose a sensing device which generates any data. The sensing device disclosed by Sekunder only senses data. The coded data on the page is an absolute coordinate and thus the sensing device only senses the data and forwards the data to the computer system. The sensing device fails to generate any data using the sensed coded data from the surface.

Thus, in relation to the sensing device generating indicating data, the third basic requirement of a Prima Facie Case of Obviousness has again not been met with regard to Patterson, Jr et al. in view of Richards and further in view of Sekunder, as all the claim limitations have not been shown by these documents.

Reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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